UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,981	03/23/2005	Jena-Marie Vau	85052DAN	6374

1333 7590 09/03/2008

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER	
KIM, HEE SOO	
ART UNIT	**PAPER NUMBER**
2157	
MAIL DATE	**DELIVERY MODE**
09/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/528,981	VAU ET AL.	
	Examiner	Art Unit	
	HEE SOO KIM	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 10-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to remarks filed on 6/04/08.

Claim amendments have not been presented in this remark.

Claims 1~8 and 10~12 are presented for examination.

Response to Arguments

Applicant's arguments filed 6/04/08 have been fully considered but they are not persuasive.

Response to Improper Rejection in the Non-Final Rejection filed on 3/05/08.
Applicant requested for clarification over the rejection of claims 2~8 stating it was confusing whether the claims were rejected over 1) Chen 2) Subrahmanyam in view of Chen, or 3) Subrahmanyam in view of AAPA and further in view of Chen. While Examiner has made an error to the name of the reference used (Subrahmanyam instead of Chen), the cited portions for each of claims 2~8 were based on the Subrahmanyam reference (primary). A simple telephone call to the Examiner would have allowed for such clarification to be made with Applicant and it is believed the error in no way would prevent Examiner to make the action Final since the cited portions were based on the Subrahmanyam reference.

Response to Rejection of Claims 1~8 and 10~12.
In response to Applicant's argument (Pg. 3, ¶1, ¶4), Applicant argues that Subrahmanyam does not teach or suggest "deleting data automatically from the second storage medium" however, it is noted that the feature upon which applicant relies is not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument (Pg. 3, ¶2), Applicant argues that "the content of the multimedia message...are archived up to the moment..." Examiner request Applicant to explicitly define what exactly "up to the moment" is really meant to be. If the length of archive is predetermined, Examiner as best understood interprets the limitation as the user accessing the message anytime it wishes. Subrahmanyam taught the user is allowed to set the storage length regardless of whether the user has accessed the archived data since the data is accessed **anytime the user wishes to do so**.

In response to Applicant's argument (Pg. 3, ¶3), Applicant argues that AAPA does not overcome the deficiency of Subrahmanyam with regards to the content of the multimedia message being temporarily saved in a server. Examiner point out AAPA was cited for the purposes to show that enabling temporary archiving of messages in a server was well-known to one of ordinary skill in the art. The duration of the archiving cited in the AAPA is simply an example however, not an example dependent upon for rejecting the claim limitation. Examiner believes such contention made by Applicant was due to the fact the references were considered individually rather than as a combination. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Thus, in view of such, the rejection is sustained as follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1~8 and 10~12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subrahmanyam (U.S 5,732,214) in view of Applicant Admitted Prior Art hereinafter 'AAPA'.

Regarding Claim 1,

Subrahmanyam taught a method enabling a communication of at least one multimedia message between at least a first and a second terminal located in a digital network comprising a first data server and a second data server, the first data server comprising a first user data base and a first storage means enabling a temporary archiving of the at least one multimedia message, and the second data server comprising a second user data base and a second storage means, said method comprising the following steps:

determine a subscription identifier to an archiving service of the second terminal, the archiving service being specific to the second data server (Col. 3, Lines 7~9);

automatically associating the receiving address with the subscription identifier to the archiving service of said second terminal (Col. 4, Lines 28~32);

automatically reformatting said multimedia message with additional data, said additional data comprising a dynamic link corresponding to the subscription identifier to perform an automatic billing of the archiving with the archiving service (Col. 4, Lines 19~22, Lines 41~50, access to the archival services are made directly or indirectly by other network nodes or other means);

automatically sending the content of said multimedia message from the first data server to the second data server (Col. 4, Lines 58~62); and

automatically archiving the content of said multimedia message in the second storage means comprised in the second data server up to the moment when said multimedia message is consulted on the second terminal (Col. 5, Lines 11~12, Col. 6, Lines 14~22).

Subrahmanyam did not teach from at least one multimedia message sent from the first terminal of the digital network and intended to be sent to a receiving address of a second terminal of said digital network, the content of said multimedia message being temporarily saved in the first storage means comprised in the first data server.

However, applicant has admitted in the background of the invention, messages exchanged between terminals are temporarily stored (archived) in a server (AAPA, Pg. 2, Lines 4~7),

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to incorporate, in Subrahmanyam's system, a server for temporarily storing data messages, as it would allow terminal users to view the data messages at a later time.

Regarding Claim 2,
Subrahmanyam taught wherein the content of the multimedia message sent comprises at least one image, at least one text element, and at least one audio partition (Col. 5, Lines 1~3).

Regarding Claim 3,
Subrahmanyam taught before the archiving step, an automatic extraction is performed from a part of the content of the multimedia message (Col. 12, Lines 30~35, file processing (i.e. extraction) is performed on the data to be archived).

Regarding Claims 4~6,
Subrahmanyam taught before the archiving step, at least one image, text element, and audio partition are extracted from the multimedia message (Col. 11, Lines 33~38, server performs any data processing (implies data can be an image, text, and/or audio) requested by user).

Regarding Claims 7,
Subrahmanyam taught the extraction is performed from the first server (Col. 11, Lines 38~50).

Regarding Claim 8,
Subrahmanyam taught the extraction is performed from the second server (Col. 11, Lines 38~50).

Regarding Claim 10,
Subrahmanyam taught the additional data comprise a notification of archiving information of the multimedia message on the second server (Col. 6, Lines 4~12).

Regarding Claim 11,
Subrahmanyam taught the additional data comprise a dynamic link to a user account of the recipient of the multimedia message (Col. 11, Lines 14~21).

Regarding Claim 12,
Subrahmanyam taught the additional data comprise a dynamic link to perform an archiving confirmation request (Col. 5, Lines 47~65, at the time of archiving, initiating transfer is based on prearranged details (a type of confirmation is needed) of what is to be transferred).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hee Soo Kim whose telephone number is (571) 270-3229. The examiner can normally be reached on Monday - Thursday 8:00AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. K./
8/18/08

/Ario Etienne/
Supervisory Patent Examiner, Art Unit 2157